

REMARKS/ARGUMENTS

This Reply is filed in response to a first Official Action on a second Request for Continued Examination (RCE) for the above-identified patent application. The first Official Action of this second RCE no longer rejects any of the pending claims under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0173295 to Nykanen et al. Instead, the first Official Action now rejects all of the pending claims, namely Claims 1-15, 18-34, 37-48, 51-59 and 62, under 35 U.S.C. § 103(a) as being unpatentable over Nykanen, in view of U.S. Patent No. 6,556,997 to Levy. As explained below, however, Applicants respectfully submit that Levy is non-analogous to the claimed invention, and may not therefore be cited in support of a § 103(a) rejection of the claimed invention. And even if Levy were analogous to the claimed invention, the claimed invention is patentably distinct from Nykanen and Levy, taken individually or in any proper combination; nor is there any apparent reason to combine Nykanen and Levy. In view of the remarks presented below, Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application.

A. Levy is Non-Analogous to the Claimed Invention

As indicated above Applicants respectfully submit that at least Levy is non-analogous to the claimed invention, and as such, cannot properly be relied upon as a basis for rejection of the claimed invention under 35 U.S.C. § 103(a). MPEP § 2141.01(a). As explained in the MPEP, to be analogous, a reference must either be in the same field as Applicants' endeavor, or if not, then be reasonably pertinent to the particular problem with which the invention is concerned. *Id.* In this regard, the Federal Circuit has stated that matter disclosed in the reference must be such that it logically would have commended itself to an inventor's attention in considering the inventor's problem. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

As explained in the MPEP, structural and functional differences are evidence of non-analogy or analogy. MPEP § 2141.01(a). In the instant case, any structural and functional similarities between Levy and the claimed invention are far outweighed by structural and functional differences therebetween. In this regard, the only structural and functional similarity between the Levy system and that of the claimed invention is that both include a mobile terminal

device. The manner (function) by which the systems of Levy and the claimed invention operate are significantly different. The claimed invention is directed to managing information related to the context or environment of a mobile station, or user of a mobile station, where at least some of that information relates to sensor measurements. Levy, on the other hand, is directed to supplying information from standard Internet web pages, corporate Intranets, corporate databases, text files, proprietary information sources (e.g., Reuters) or the like. That is, in contrast to the claimed invention being concerned with managing information related to an environment of a mobile station (or user) where at least some of that information relates to sensor measurements, Levy is directed to supplying information from documentary sources. For at least this functional difference, Applicants respectfully submit that Levy is in a different field from that of the claimed invention, nor is Levy reasonably pertinent to the particular problem with which the claimed invention is concerned.

Applicants therefore respectfully submit that as Levy is non-analogous to the claimed invention, Levy cannot be relied on as a basis for rejecting the claimed invention under 35 U.S.C. § 103(a).

B. Claims 1-15, 18-34, 37-48, 51-59 and 62 are Patentable over Nykanen in view of Levy

Even if one could argue (albeit incorrectly) that Levy is analogous to the claimed invention, Applicants respectfully submit that the claimed invention is still patentably distinct from Nykanen and Levy, taken individually or in combination.

According to one claimed aspect of the present invention, independent Claim 1 provides an apparatus including a context engine and a communication manager. As recited, the context engine is configured for storing context-related information, the context-related information having been created based upon at least a portion of one or more conditions (e.g., sensor readings). In this regard, the context engine is also configured for managing an exchange of the context-related information with one or more context consumers. In turn, then, the communication manager is configured for communicating with one or more context consumers for receiving one or more context rules and exchanging context-related information, with one or

more of those context consumer(s) being located external to the apparatus. In this regard, the context rule(s) include one or more condition values relating to at least a portion of context-related information, and further include one or more actions to be performed. The mobile station further includes a script engine configured for executing at least a portion of one or more context rules, including performing at least a portion of respective action(s), based on a comparison of the respective at least one condition value and one or more conditions measured by one or more sensors.

As previously explained, in contrast to the claimed invention, Nykanen does not teach or suggest an apparatus including a communication manager configured to receive context rule(s) including condition value(s) relating to context-related information, and one or more actions to be performed; and a script engine configured to execute context rule(s), including performing at least a portion of respective action(s) based on a comparison of the respective condition value(s) and one or more conditions measured by one or more sensors. The first Official Action of this second RCE concedes that Nykanen does not reach or suggest the recited script engine, but alleges that Levy discloses this feature, and that it would have been obvious to one skilled in the art to modify Nykanen per Levy to teach the claimed invention. Applicants respectfully disagree.

In the first Official Action, the Examiner cites the following passage of Levy for allegedly disclosing the script engine feature of the claimed invention:

Schedule and retrieval engine (SRE) 28 accesses the profile database 20 on a scheduled basis, as frequently as resources allow, and compares the requested delivery times with the current system time clock. When information is to be delivered to a specific customer, the SRE 28 accesses the peeler server 32, which functions to retrieve the information from the web page containing the requested information from the Internet 14 via the proxy server 34, and fire wall 36. A cache memory 40 is provided for proxy server 34, to reduce the amount of repetitive retrievals required.

Levy, col. 7, ll. 5-17. In the cited passage, Levy discloses comparing requested delivery times (from a profile database) with a current system time clock. The claimed invention, on the other hand, recites comparison of a condition value (related to context-related information) with a condition measured by a sensor. Even if one could argue that either requested delivery times or

time from a current system time clock correspond to a condition value (although expressly without admission by Applicants as to its accuracy), under no reasonable interpretation does the other of requested delivery times or time from a current system time clock correspond to a condition measured by a sensor. Applicants acknowledge that during prosecution, the claims are to be given their broadest reasonable interpretation, but note that that interpretation must be consistent with the specification as well as the interpretation that those skilled in the art would reach. MPEP § 2111 (*citing In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999)). And not only would the aforementioned interpretation of a condition measured by a sensor (i.e., current system time clock) not be consistent with the specification or interpretation that those skilled in the art would reach, but such an interpretation would not be consistent with that of Nykanen into which the aforementioned feature is allegedly combinable to teach the claimed invention.

C. No Apparent Reason to Combine Nykanen and Levy

Moreover, Applicants respectfully submit that there is not any apparent reason to combine Nykanen and Levy, nor has the Official Action provided a sufficient reason for their combination. In this regard, Applicants acknowledge that the Supreme Court's recent decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007), rejected a rigid application of the "teaching, suggestion or motivation" (TSM) test. Nonetheless, the Court did state that obviousness often requires determining whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue, and that to facilitate review, this analysis should be made explicit. *See KSR Int'l. Co.*, 127 S.Ct. at 1740-41, 82 USPQ2d (BNA) at 1396. Even further, the Court noted that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, 127 S.Ct. at 1740-41, 82 USPQ2d (BNA) at 1396, *citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d (BNA) 1329 (Fed. Cir. 2006) (*emphasis added*).

As clearly explained by the Supreme Court, then, any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. In the instant case, the Examiner attempts to support the alleged

combination of Nykanen and Levy by merely asserting that one skilled in the art would have been led to the combination to realize “a method and device for easily defining new information services for delivery to customers.” Official Action of December 14, 2007, page 5. However, the Examiner fails to provide any articulated reasoning with any rational underpinning to support that conclusion, particularly given that Levy alone claims to provide the alleged method and device (and without any combination with Nykanen). And in line with the Court in *KSR Int'l. Co.*, an obviousness rejection cannot be sustained by merely concluding that one skilled in the art would have found it obvious to modify Nykanen per Levy due to some unsupported, alleged realized combination, without some explicit reasoning with some rationale underpinning that conclusion.

For at least the foregoing reasons, Applicants respectfully submit that independent Claim 1, and by dependency Claims 2-15, 18 and 19, is patentably distinct from Nykanen, in view of Levy. Applicants also respectfully submit that independent Claims 20, 40 and 52 recite subject matter similar to independent Claim 1, including the aforementioned communication manager and script engine features of receiving context rule(s) and executing those rule(s) based on a comparison of condition value(s) and condition(s) measured by one or more sensors. Accordingly, Applicants respectfully submit that independent Claims 20, 40 and 52, and by dependency Claims 21-34, 37-39, 41-48, 51, 53-59 and 62, are also patentably distinct from Nykanen for at least the same reasons given above with respect to independent Claim 1. Applicants therefore respectfully submit that the rejection of Claims 1-15, 18-34, 37-48, 51-59 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Nykanen, in view of Levy is overcome.

CONCLUSION

In view of the remarks presented above, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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